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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,219	04/26/2001	Lyle Theisen	P04822US0	8367

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1619

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DATE MAILED: 12/21/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/843,219

Applicant(s)

THEISEN, LYLE

Examiner

Gina C. Yu

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

Claim 20 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claim(s) in alternative only. See MPEP § 608.01(n). Accordingly, the claim 20 has not been further treated on the merits.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-5<sup>6-8</sup>, 10, and 16-17<sup>19, 20</sup> are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "cholesterol" in claims 3, 10, and 16 is used by the claim to include fatty substances from plants listed in specification p. 5, lines 15 – 30, while the accepted meaning of the term "cholesterol" is a sterol or lipid found in animals.

Claim 6 is vague and indefinite because the claim, <sup>recites "a benzene", however it</sup> appears that applicant intends to claim benzene-containing compounds, not just benzene. Claim 19 is rejected for the same reason

The remaining claims are rejected as depending on the indefinite base claim.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

1. Claims 1, 11-13, and 15 rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Simon (US 6080415).

Simon discloses photochromic cosmetic make-up products which renders reversible coloring effect in response to light. See abstract; col. 1, line 7 – col. 2, line 5. Examiner views that the stability of the composition as in instant 11 is inherent as the prior art reads on all the limitation of its base claim 1. A nail varnish formulation, which examiner views as a suspension, is illustrated in col. 13, meeting instant claim 13.

2. Claim 1, 2, 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohno et al. (US 5628934) "Ohno".

Ohno discloses photochromic cosmetic composition which responds to the intensity of light. See abstract; col. 2, line 55 – col. 3, line 4; col. 8, lines 16 – col. 9, line

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26. In view of the teaching on the stability of the photochromic material in the invention, examiner takes the position that instant claim 11 is met. Example 7 illustrate an emulsified foundation comprising a photochromic zinc oxide compound, triethanol amine which acts as a buffer, preservatives, and perfume, meeting instant claims 12, 13, and 15.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hippely et al. (US 5503583) ("Hippely").

Hippely discloses a reversible thermochromic composition used in painting toys, meeting instant claim 1, which is directed to a composition.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6-9, and 19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakanishi et al. (US 5017225) ("Nakanish") in view of Sato (US 5700453).

Nakanish teaches a water-based photochromic ink comprising spirooxazine compounds. The invention employs a solvent having a solubility of 15 wt % in water or more, such as benzene and azobenzene, UV absorber, and antioxidant. See col. 1, line 19 – col. 3, line 24; col. 7, line 57 – col. 8, line 59. See Examples for the coloring/decoloring effect of the composition. The acrylic copolymers used as binders in

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the composition are taught in col. 8, lines 36 – 53; Example 1. The pH of the composition is said range from 5 to 9, meeting instant claim 14. The reference teaches that the invention is applicable to cosmetics. See col. 27, lines 55 – 68. The reference lacks the specific compounds of instant claim 8.

Sato teaches lipcolor compositions comprising a salt of di-or trivalent metals such as calcium citrate and an oil components, which is said to impart less dry feeling or uneasy feeling upon the application of the composition than prior arts. See col. 1, line 15 – col. 2, line 18.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the photochromic composition of Nakanish by incorporating calcium citrate, as suggested by Sato, because of the expectation of successfully producing photochromic cosmetic composition with less dry feeling and more comfortable wear.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kamata et al., US 5431697.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-305-3593.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
December 16, 2001



DIANA DUDASH  
SUPERVISORY PATENT EXAMINER  
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